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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,739	03/22/2004	Kent F. Hayes JR.	RSW920030234US1	9574

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EXAMINER

NGUYEN, VAN H

ART UNIT	PAPER NUMBER
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2194

MAIL DATE	DELIVERY MODE
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09/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/805,739

Applicant(s)

HAYES, KENT F.

Examiner

VAN H. NGUYEN

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/22/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to the application filed 03/22/2004.

Claims 1-31 are currently pending in this application.

Examiner requests that Applicant review the application carefully for informalities including typographical errors.

Oath/Declaration

2. The Office acknowledges receipt of a properly signed Oath/Declaration submitted 03/22/2004.

Information Disclosure Statement

3. The Applicants' Information Disclosure Statement, filed 03/22/2004, has been received, entered into the record, and considered.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an

invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-31 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-40 of copending Application No. 10/805963; and over claims 1-32 copending Application No. 10/78752.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on the copending applications since the referenced copending applications and the instant application are claiming common subject matter, if not identical subject matter.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending applications. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

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This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-11 do not fall within one of the four enumerated categories of patentable subject matter recited in section 101 (process, machine, manufacture or composition of matter).

Claims which are broad enough to read on statutory subject matter or on non-statutory subject matter are considered non-statutory. Cf. In re Lintner, 458 F.2d 1013, 1015, 173 USPQ 560, 562 (CCPA 1972) (“Claims which are broad enough to read on obvious subject matter are unpatentable even though they also read on nonobvious subject matter.”) During prosecution, applicant can amend to limit the claims to statutory subject matter.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-31 are rejected under 35 U.S.C. 102(e) as being anticipated by **Mitchell et al.** (US 20040117494 A1).

As to claim 1:

Mitchell teaches a tunable prerequisite resolution engine for client devices in an Open Service Gateway Initiative (OSGi) framework, comprising: a prerequisite computation system for determining, on a server, necessary prerequisites for one or more OSGi bundle(s) to be run on a client device; a bundle identification system for identifying possible combinations of OSGi bundles on the server that fulfill any of the necessary prerequisites that are lacking from the client device; a data access system for accessing a configuration corresponding to the client device, wherein the configuration sets forth computer resource types, and corresponding normalization factors and importance factors for the client device;

and a bundle selection system for selecting a final combination of OSGi bundles from the possible combinations of OSGi bundles by processing the configuration and computing based on amounts of the computer resources needed by each of the possible combinations of OSGi bundles (*see the Abstract; the OSGi framework and OSGi bundles discussion; ¶¶ 0011-0012 and 0018-0052; see also, Figs.1-5*).

As to claim 2:

Mitchell teaches a communication system for communicating the prerequisites from the server to the client device, and for receiving a response from the client device, wherein the response identifies any of the necessary prerequisites that are lacking from the client device (*see the Abstract; ¶¶ 0011 and 0024-0030; see also, Figs.1-5*).

As to claim 3:

Mitchell teaches the configuration is accessed from among a group of properties files, and wherein each of the group of properties files is configured for a particular different client device (*see ¶¶ 0024-0040; see also, Figs.1-5*).

As to claim 4:

Mitchell teaches the bundle selection system, comprises: an amount determination system for determining amounts of the computer resources needed by each of the possible combinations of OSGi bundles; a product determination system for determining products for each of the possible combinations of OSGi bundles by

multiplying each of the amounts by the corresponding normalization factors and importance factors set forth in the configuration; a score determination system for determining a composite score for each of the possible combinations of OSGi bundles by summing the corresponding products; and a bundle system for selecting the final combination of OSGi bundles from the possible combinations of OSGi bundles based on the composite scores (*see the Abstract; the OSGi framework and OSGi bundles discussion; ¶¶ 0011-0012 and 0018-0052; see also, Figs. 1-5*).

As to claim 5:

Mitchell teaches the computer resources types are *selected from the group consisting* of a bundle storage requirement, a new space size, an old space size, an open file quantity, a quota, a memory requirement, a socket quantity, and a thread quantity (*see ¶¶ 0033-0039; see also, Figs. 1-5*).

As to claim 6:

Mitchell teaches a configuration system for setting the configuration for the client device (*see ¶¶ 0026-0029; see also, Figs. 1-5*).

As to claim 7:

Mitchell teaches the prerequisites comprise *at least one of* a service and/or package (*see ¶¶ 0023-0026; see also, Figs. 1-5*).

As to claim 8:

Mitchell teaches the client device comprises: an analysis system for determining whether any of the necessary prerequisites are lacking from the client device; and a response system for generating and sending a respond to the server (see ¶¶ 0022-0030; *see also, Figs.1-5*).

As to claim 9:

Mitchell teaches the client device communicates with the server over the Internet (see ¶0022).

As to claim 10:

Mitchell teaches the configuration sets forth computer resource types, and corresponding normalization factors and importance factors for a particular type of client device (see ¶¶ 0022-0030; *see also, Figs.1-5*).

As to claim 11:

Mitchell teaches the configuration sets forth computer resource types, and corresponding normalization factors and importance factors for a group of client devices (see ¶¶ 0022-0030; *see also, Figs.1-5*).

As to claim 12:

Mitchell teaches a computer-implemented method for resolving prerequisites for client devices in an Open Service Gateway Initiative (OSGi) framework, comprising: determining, on a server, necessary prerequisites for an OSGi bundle to be run on a client device; identifying possible combinations of OSGi bundles on the server that fulfill any of the necessary prerequisites that are lacking from the client device; accessing, from the server, a configuration corresponding to the client device, wherein the configuration sets forth computer resource types and corresponding normalization factors and importance factors for the client device; and selecting a final combination of OSGi bundles from the possible combinations of OSGi bundles by processing the configuration based on amounts the computer resources needed by each of the possible combinations of OSGi bundles (*see the OSGi framework and OSGi bundles discussion; ¶¶ 0011-0012 and 0018-0052; see also, Figs.1-5*).

As to claim 13:

Mitchell teaches querying the client device to determine if the client device has the necessary prerequisites; and receiving a response from the client device that identifies any of the necessary prerequisites that are lacking on the client device, prior to the determining step (*see the Abstract; ¶¶ 0011 and 0024-0030; see also, Figs.1-5*).

As to claim 14:

Mitchell teaches caching the response on the server (*see ¶¶ 0021-0022*).

As to claim 15:

Mitchell teaches the selecting step comprises: determining amounts of the computer resources needed by each of the possible combinations of OSGi bundles; determining products for each of the possible combinations of OSGi bundles by multiplying each of the amounts by the corresponding normalization factors and importance factors set forth in the properties files; determining a composite score for each of the possible combinations of OSGi bundles by summing the corresponding products; and selecting the final combination of OSGi bundles from the possible combinations of OSGi bundles based on the composite scores (*see the OSGi framework and OSGi bundles discussion; ¶¶ 0011-0012 and 0018-0052; see also, Figs.1-5*).

As to claim 16:

Mitchell teaches the possible combination of OSGi bundles having the lowest composite score is selected as the final combination of OSGi bundles (*see ¶¶ 0018-0052; see also, Figs.1-5*).

As to claim 17:

Mitchell teaches the configuration is accessed from among a group of properties files, and wherein each of the group of properties files is configured for a specific client device (*see ¶¶ 0024-0040; see also, Figs. 1-5*).

As to claims 18 and 19:

Refer to claims 5 and 7 above, respectively, for rejections.

As to claim 20:

Mitchell teaches the method is performed recursively (*see ¶¶ 0018-0052; see also, Figs. 1-5*).

As to claims 21-31:

Refer to claims 1-11 above, respectively, for rejections.

Conclusion

7. The prior art made of record, see PTO 892, and not relied upon is considered pertinent to applicant's disclosure. Applicant should review these references carefully before responding to this office action.

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Contact Information

8. Any inquiry or a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: (571) 272-2100.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VAN H. NGUYEN whose telephone number is (571) 272-3765. The examiner can normally be reached on Monday-Thursday from 8:30AM- 6:00PM. The examiner can also be reached on alternative Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WILLIAM THOMSON can be reached at (571) 272-3718.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://padirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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P O Box 1450
Alexandria, VA 22313-1450



VAN H. NGUYEN
PRIMARY EXAMINER